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OFFICE OF PETITIONS

In re Application of :
Claire Roberts : DECISION DISMISSING PETITION
Application No. 10/789,105 : UNDER 37 CFR 1.78(a)(3)
Filed: February 27, 2004 :
Attorney Docket No. LP-02-019 :
:

This is a decision on the petition under 37 CFR 1.78(a)(6), filed October 17, 2005, which is being treated as a petition under 37 CFR 1.78(a)(3) to accept an unintentionally delayed claim under 35 U.S.C. § 120 for the benefit of priority to the prior-filed International Application No. PCT/AU02/01226, filed August 30, 2002.

The petition is **DISMISSED**.

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii). In addition, the petition under 37 CFR 1.78(a)(3) must be accompanied by:

- (1) the reference required by 35 U.S.C. § 120 and 37 CFR 1.78(a)(2)(i) of the prior-filed application, unless previously submitted;
- (2) the surcharge set forth in § 1.17(t); and
- (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

The instant petition does not comply with item (1) above.

The Office notes that the instant nonprovisional application was not filed within 12 months from the filing date of the prior-filed international application. Therefore, the amendment on page one of the specification following the title is not acceptable as drafted because it improperly seeks to claim priority under 35 U.S.C. § 119(e) to International Application No. PCT/AU02/01226, filed August 30, 2002.

The Office further notes that 37 CFR 1.78(a)(2)(i) requires that any nonprovisional application claiming the benefit of one or more prior-filed international applications designating the United States of America must contain or be amended to contain a reference to each such prior-filed application, identifying it by international application number and international filing date, and indicating the relationship of the applications. The relationship between the applications is whether the subject application is a continuation, divisional, or continuation-in-part of a prior-filed application. An example of a proper benefit claim is: "This application is a continuation application of International Application No. PCT/US--/---, filed ---." The amendment, filed October 17, 2005, fails to comply with the provisions of 37 CFR 1.78(a)(2)(iii), and therefore, is unacceptable.

Lastly, 37 CFR 1.78(a)(3) requires a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and the date the claim was filed was unintentional. Because the statement contained in the instant petition varies from the language required by 37 CFR 1.78(a)(3), the statement contained in the instant petition is being construed as the statement required by 37 CFR 1.78(a)(3).

Accordingly, before the petition under 37 CFR 1.78(a)(3) can be granted, applicant must file a renewed petition under 37 CFR 1.78(a)(3) and a substitute amendment¹ or an Application Data Sheet, which sets forth the relationship of the prior-filed application.

Further correspondence with respect to this matter should be addressed as follows:

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¹ Note 37 CFR 1.121 and 37 CFR 1.4(c).

Any inquiries concerning this decision may be directed to Senior Petitions Attorney Christina Tartera
Donnell at (571) 272-3211.

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